

DOCKET NO.: 275744US6



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:

GROUP: 2623

Tatsuo KAIZU, et al.

SERIAL NO: 10/039,826

EXAMINER: SHEPARD, J.

FILED: October 23, 2001

FOR: INFORMATION PROCESSING APPARATUS, INFORMATION  
PROCESSING METHOD, AND PROGRAM STORAGE MEDIUM

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

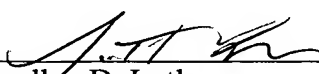
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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REMARKS ACCOMPANYING  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

FAILURE TO PRESENT A *PRIMA FACIE* CASE OF OBVIOUSNESS

Applicants submit that the Official Action of July 18, 2006 has failed to provide a *prima facie* case of obviousness with respect to Claims 1-8 35 U.S.C. § 103.<sup>1</sup>

Pending Claims 1-5, 7 and 8 stand rejected under 35 U.S.C. § 103 over Levine in view of Elliot. As outlined in detail in the response filed June 23, 2006, this rejection is deficient in that it does not provide any disclosure or suggestion, relative to Elliot, of any feature of communication circuitry (114), which enables an automatic download.

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<sup>1</sup> See Official Action of July 18, 2006 detailing the rejection of Claims 1-5, 7 and 8 under 35 U.S.C. § 103 based on U.S. Patent No. 5,692,214 to Levine in view of U.S. Patent No. 6,590,503 to Elliot in view of U.S. Patent No. 6,590,503 to Elliot and the rejection of Claim 6 in view of Levine and Elliot in further view of U.S. Patent No. 5,537,473 to Saward.

Specifically, in the Advisory Action dated July 18, 2006, the explanation was provided that:

Elliot makes no mention of the user manually navigating to a website and the examiner interprets this as meaning that the device itself navigates to the website to automatically download the necessary codes to perform the required action. Therefore the rejection stands.<sup>2</sup>

Elliot describes a remote control system (100), which includes communication circuitry (114).<sup>3</sup> The communication circuitry is described as either a modem or memory cartridge reader.<sup>4</sup> The function of the communication circuitry is described as being an alternative to a pre-programmed memory in that a code library may be downloaded to the memory via the communication circuitry.<sup>5</sup>

More specifically, Elliot provides:

The contents of the code library are determined by the desired functionality of the remote control system. For example, if the remote control circuitry is to be incorporated in a set-top box for a cable television system, the code library may contain codes usable to generate infrared signals for controlling one or more devices such as television sets, video recording/playback devices, audio equipment, computer equipment, game consoles, portable (hand-held) game machines, camcorders, etc. ... If the remote control system is incorporated in a device configured to access the WorldWide Web, some or all of the contents of the code library may be downloaded by accessing a particular website and selecting codes that are appropriate for the device or the desired functionality of the device. In this case, communication circuitry 114 may comprise a modem.<sup>6</sup>

As can be appreciated, there is no disclosure, suggestion or any discussion whatsoever which describes the communication circuitry (114) automatically obtaining code information as recited in the Applicants' claims.

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<sup>2</sup> See Advisory Action of July 18, 2006, at page 2.

<sup>3</sup> Elliot at Figure 2.

<sup>4</sup> Elliot at column 3, lines 39-59.

<sup>5</sup> Elliot at column 3, lines 40-42 and 48-53.

<sup>6</sup> Elliot at column 3, lines 27-33 and lines 42-55.

As noted above, the Advisory Action of July 18, 2006 provides no such analysis or discussion with respect to the actual teachings of Elliot in support of its rejection. In this regard it is noted that the patent office has the initial duty of supplying the factual basis for its rejection. It may not because it doubts the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Indeed, the Advisory Action attempts to prove its leap in logic by discussing what Elliot does not describe instead of discussing what Elliot describes. There is no disclosure in Elliot which explains how the communication circuitry (114) could determine desired functionality and automatically download codes via the Internet as speculated in the Official Action.

As such, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that the rejection of Claims 1-5, 7 and 8 under 35 U.S.C. §103 be withdrawn and prosecution be opened in view of the clear factual deficiencies outlined above.<sup>7</sup>

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<sup>7</sup> Applicants submit that the rejection of Claim 6 under 35 U.S.C. §103 over Levine, Elliot and in further view of Saward is likewise deficient for the reasons stated herein.

CONCLUSION

As the Office has failed to establish a *prima facie* case of obviousness in view of the clear factual and legal deficiencies outlined above, Applicants respectfully request that the prosecution be reopened.

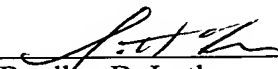
Respectfully submitted,

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